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Kenya T. Pierre Name of Attorney	Registration No. 50,165
Signature of Attorney	

P&G Case 8163

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the application of :
MICHAEL L. VATTER : Confirmation No. 7755
 Serial No. 09/902,048 : Group Art Unit 1619
 Filed July 10, 2001 : Examiner Michael Willis

For **TRANSFER-RESISTANT MAKE-UP REMOVING COMPOSITIONS**

BRIEF ON APPEALS

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Dear Sir:

Enclosed, pursuant to 37 C.F.R. 1.192(a), is Appellant's brief on Appeal for the above application. The Brief is being forwarded in triplicate.

Please charge the fee of \$320.00 pursuant to 37 C.F.R. 1.17(c) to Deposit Account No. 16-2480 for the filing of the brief in support of an appeal. The Commissioner is also authorized to charge any additional fees which may be required to this account. A duplicate copy of this sheet is enclosed.

Respectfully submitted,
 By _____
 Kenya T. Pierre
 Attorney for Applicants
 Registration No. 50,165
 (513) 626-4055

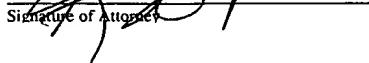
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Serial No. 09/902,048 : Group Art Unit: 1619
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Title: TRANSFER-RESISTANT :
MAKE-UP REMOVING COMPOSITIONS :

APPEAL BRIEF

Mail Stop Appeal Brief – Patents
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Alexandria, Virginia 22313-1450

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Dear Sir,

This Appeal Brief is submitted in support of the Notice of Appeal filed on March 7, 2003, setting a two month period for response.

REAL PARTY IN INTEREST

The real party in interest is The Procter & Gamble Company of Cincinnati, Ohio. The Inventor Michael Lee Vatter assigned his interest to The Procter & Gamble Company which was recorded on September 10, 2001, reel 12155, frame 673.

RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences known to the Appellant, or known to Appellant's legal representative that will directly affect, will be directly affected by, or will have a bearing on the Board's decision in the present appeal.

STATUS OF CLAIMS

Claims 1-12 are pending and stand rejected. A copy of these claims, which are being appealed, appear in the Appendix.

STATUS OF AMENDMENTS

In response to the Non-final Office Action dated March 19, 2002, Appellant amended Claims 1, 7, and 10-12. In the Final Office Action of December 18, 2002, the Office indicated that the aforementioned amendments have been entered. No amendments were submitted by Appellant subsequent to the final Official Action.

SUMMARY OF THE INVENTION

The compositions of the present invention relate to a method for removing transfer resistant make-up compositions comprising the step of applying a safe and effective amount of a make-up removing composition comprising:

- (i) from 0.1 to 30% of a crosslinked siloxane elastomer said elastomer having a particle size of from above 10 to about 200 microns;
- (ii) from 10 to 80% of a solvent having a solubility parameter of less than or equal to about 9 (cal./cm³)^{1/2}; and
- (iii) optionally, from about 0% to about 90% water.

ISSUES

Appellant presents the following issues for consideration on appeal:

- I. Under 35 USC §103, do the general disclosures of the cited references provide the motivation necessary to combine and motivate a skilled artisan to arrive at the instantly claimed methods for removing transfer resistant makeup compositions?
- II. Under 35 USC §103, do the general disclosures of the cited references provide the motivation necessary to combine and motivate a skilled artisan to arrive at the instantly claimed cosmetic removing wipe?

GROUPING OF CLAIMS

Claims 1-12 stand or fall together.

ARGUMENTS

In the Office Action dated March 19, 2002, the Office rejected claims 1-12 under 35 USC§103(a) as being unpatentable over Schulz et al, USP No. 5,654,362 (hereinafter “Schulz”) in view of Dreschler et al., USP No. 6,071,503 (hereinafter “Dreschler”). The Office states that it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the compositions and methods for makeup removal as taught by Schulz by removing transfer resistant makeup with the further use of a tissue in order to benefit from the removal of transfer resistant makeup as taught by Dreschler. In response to Appellant’s response last submitted, the Office adds that Dreschler teaches the use of dimethicone-based cosmetic remover in combination with a tissue to remove transfer-resistant makeup. Furthermore, the Office states that Schulz teaches the use of silicone elastomers in combination with dimethicone-based fluids for compositions such as color cosmetic removers. Thus, the Office believes that Schulz’s teachings of silicone-based cosmetic removers with silicone elastomers would have suggested the use of such cosmetic removers for the removal of transfer-resistant makeup where the prior art of Dreschler teaches such a use for silicone-based cosmetic removers.

In view of the foregoing, the Office is of the opinion that the claimed invention is clearly obvious in view of the prior art.

For the reasons that will be set forth below, Appellant submits that Claims 1-12 are nonobvious over and patentably distinct from the cited references. Thus, the Board should reverse the Examiner’s rejections. Accordingly, the favorable action by the Board is respectfully requested.

- I. **Claims 1-12 are not obvious in view of the cited references under 35 USC §103(a) because the references fail to teach or suggest Appellant’s elastomer having a particle size of from above 10 to about 200 microns or from about 10 to about 80% of a solvent having a solubility parameter of less than or equal to about 9 (cal./cm³)^{1/2} as components of Appellant’s make-up removing composition.**

Appellant respectfully submits that the claimed invention would not have been obvious over the cited references. Schulz discloses methods of thickening silicone oils or other solvents to gel-like consistency by reacting ≡Si-H containing polysiloxane with an alpha, omega-diene. The reaction is conducted in the presence of a platinum catalyst and a low molecular weight silicone oil. Dreschler relates to cosmetic compositions for application to the lips that includes a mixture of a specific organosiloxane resin and a dimethicone gum, a volatile carrier, and a pigment wherein these ingredients are present in specific ratios. Despite Dreschler’s teaching of compositions that are transfer resistant,

Appellant finds no specific teaching or suggestion to use Appellant's silicone elastomer-containing compositions to remove such compositions. Although Schulz subtly discloses the use of its silicone elastomers in the cosmetic arena, it fails to remedy the removal of makeup that is specifically transfer resistant. In fact, Schulz fails to teach or suggest the use of Appellant's specified silicone elastomer in combination with a particular solvent in such claimed amounts that allows for thorough makeup removal which, after removal of the makeup, impart a smooth, silky soft feel to the skin. Appellant respectfully submits that the components and parameters claimed in the instant invention provide a ratio that must be taught or suggested in order to effectively and aesthetically remove transfer resistant products and arrive at the presently claimed invention. Schulz merely mentions the use of silicone elastomers as leveling and spreading agents and therefore, does not provide the motivation necessary to arrive at Appellant's invention whereby silicone elastomers are used as active agents for removing transfer resistant cosmetics. Appellant respectfully submits that the present invention does not concern itself with leveling and spreading properties, but rather, focuses on the aesthetics of improving the after feel with the removal of transfer resistant compositions.

While the Office identifies the use of elastomers as a powder in the formulation of Schulz as falling within Appellant's particle size range, Appellant respectfully submits that such a disclosure does not teach or suggest Appellant's limitations such that one could arrive at the present invention. First, Appellant teaches from about 0.1 to 30% of a crosslinked siloxane elastomer said elastomer having a particle size of from above 10 to about 200 microns are necessarily combined with from about 10 to about 80% of a solvent having a solubility parameter of less than or equal to about 9 (cal./cm³)^{1/2}. Appellant's specific parameters teach that the solvent, when combined with the cross-linked organopolysiloxane elastomer particles, serves to suspend and swell the elastomer particles to provide an elastic, gel-like network or matrix. This results in a better balance between gel ball formation and viscosity as well as skin feel and viscosity. Secondly, even if one skilled in the art would understand Schulz's silicone powders as that which are in the particle size range of Appellant, one would not know Appellant's claimed amount of such particles and with which solvents to combine such particles in order to arrive at Appellant's claimed invention of a transfer resistant makeup remover. The Office identifies Schulz's list of dimethicone-based fluids as that which are disclosed for teaching the combination of silicone elastomers and dimethicone-based fluids. Appellant respectfully submits that such disclosure would not amount to the claimed invention at hand. The listing of such solvents by Schulz fails to identify Appellant's particular solvent of from about 10 to about 80% having a solubility parameter of less than or equal to about 9 (cal./cm³)^{1/2} that will be compatible with Appellant's particular elastomers. Thus, the mere laundry list of solvents disclosed by Schulz would not provide the teachings of Appellant's specific

transfer resistant makeup remover that is not only effective at removing makeup in a non-messy manner but also imparts an improved feel on the skin.

Even if one skilled in the art were to combine the disclosures of both Schulz and Dreschler as suggested by the Office, one would still fall short of Appellant's claimed invention. Because Dreschler merely discloses petrolatum or a dimethicone-based cosmetic remover, Appellant respectfully submits that one would not be motivated to combine the particles of Schulz with Dreschler to arrive at Appellant's presently claimed invention without unnecessary and undue experimentation. In order to swell Appellant's particles and thus arrive at a functional and aesthetically-pleasing transfer-resistant makeup remover, a specific dimethicone must be used with a particular solubility parameter. Reading the cited references, one skilled in the art would only fall short or completely fail to arrive at the presently claimed invention. There is no motivation or desire to arrive at the specifics necessary to obviate Appellant's invention. In determining obviousness, “[t]he claimed invention must be considered as a whole, and the question is whether there is something in the prior art as a whole to suggest the desirability, and the obviousness of making the combination.” *Lindeman Maschinenfabrick GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1462 (Fed. Cir. 1984); *Maize*, 5 USPQ 1788, 1793 (Fed. Cir. 1988). The fact that the references relate to the same area of technology is insufficient. *In re Geiger*, 2 USPQ2d 1276, 1278 (Fed. Cir. 1987). It is well settled that the Examiner cannot pick and choose among individual elements of assorted prior art references to recreate the claimed invention based on the hindsight of Applicants' invention. Rather, the Examiner has the burden to show some teaching or suggestion in the references to support their use in the particular claimed combination. See, *SmithKline Diagnostics, Inc. v. Helena Laboratories Corp.*, 8 USPQ2d 1468, 1475 (Fed. Cir. 1985). Based on the foregoing, a rejection under 35 USC §103(a) is, therefore, improper and should respectfully be withdrawn.

II. Claims 1-12 are not obvious in view of the cited references under 35 USC §103(a) because the references fail to teach or suggest Appellant's claimed cosmetic removing wipe.

Schulz fails to teach or suggest the claimed cosmetic wipe that includes a layered substrate and a composition comprising Appellant's specific elastomer, solvent, and optionally water in the requisite amounts. Rather, the reference teaches the use of petrolatum or dimethicone-based cosmetic removers paired with tissues for makeup removal. For the reasons stated above, one skilled in the art would not have been motivated by Dreschler to arrive at the method and wipe of the present invention since there is no teaching of a make-up removing composition comprising (i) from about 0.1 to about 30% of a crosslinked siloxane elastomer said elastomer having a particle size of from about 10 to about 200 microns; (ii) from about 10 to about 80% of a solvent having a solubility parameter of less than or equal

to about 9 (cal./cm³)^{1/2}; and (iii) optionally, from about 0% to about 90% water. Further, there is nothing in either reference regarding the use of a cosmetic removing wipe comprising one or more layers of a water-insoluble substrate. It would be improper to compare the disclosure of a tissue to the teachings of Appellant's one or more layered water-insoluble substrate. Such compositions are technologically distinct and incomparable.

SUMMARY

Given the references' failure to teach or suggest the specifically claimed method and wipe of the present invention, it would not have been obvious to a skilled artisan aware of the references to arrive at Appellant's presently claimed invention. Appellant respectfully submits that the Examiner's rejection of Claims 1-12 as being unpatentably obvious under 35 USC §103(a) is improper. Reversals by the Board of the Examiner's rejections are, therefore, respectfully requested.

MICHAEL LEE VATTER

By _____
Kenya T. Pierce
Attorney for Appellants
Registration No. 50,165
(513) 626-4055

May 7, 2003
Customer No. 27752

APPENDIX
Appealed Claims: Serial No. 09/902,048

1. A method for removing transfer resistant make-up compositions comprising the step of applying a safe and effective amount of a make-up removing composition comprising:
 - (i) from about 0.1 to about 30% of a crosslinked siloxane elastomer said elastomer having a particle size of from above 10 to about 200 microns;
 - (ii) from about 10 to about 80% of a solvent having a solubility parameter of less than or equal to about 9 (cal./cm³)^{1/2}; and
 - (iii) optionally, from about 0% to about 90% water.
2. The method of Claim 1 wherein the transfer resistant make-up is silicone gum or resin based.
3. The method of Claim 2 wherein the make-up removing composition further comprises a skin conditioning agent.
4. The method of Claim 1 wherein the skin conditioning agent is selected from the group consisting of humectants, exfoliants, emollients and mixtures thereof.
5. The method of Claim 4 wherein the skin conditioning agent is a humectant.
6. The method of Claim 5 wherein the humectant is selected from the group consisting of propylene glycol, dipropylene glycol, polypropylene glycol, polyethylene glycol, sorbitol, hydroxypropyl sorbitol, hexylene glycol, glycerin, 1,3-butylene glycol, 1,2,6-hexanetriol, ethoxylated glycerin, propoxylated glycerin and mixtures thereof.
7. The method of Claim 1 wherein the make-up removing composition further comprises an emulsifier.
8. The method of Claim 7 wherein the emulsifier is polyoxyalkylene copolymer.
9. The method of Claim 8 wherein the polyoxyalkylene copolymer is dimethicone copolyol.
10. The method of Claim 1 wherein the crosslinked siloxane elastomer is a mixture of non-emulsifying and emulsifying crosslinked siloxane elastomers.

11. The method of Claim 1 wherein makeup removing compositions further comprises an active selected from the group consisting of peptides, palmitoyl-oligopeptide, farnesol, bisabolol, phytantriol, glycerol, urea, guanidine, ascorbic acid, vitamin A, vitamin E, vitamin B₃, vitamin B₅, sunscreens, anti-acne medicaments; antioxidants, flavonoids, skin soothing and healing agents, chelators, sequestrants, opacifiers and mixtures thereof.
12. A cosmetic removing wipe, comprising:
 - A. one or more layers of water-insoluble substrate; and
 - B. a safe and effective amount of a make-up removing composition comprising:
 - (i) from about 0.1 to about 30% of a crosslinked siloxane elastomer said elastomer having a particle size of from above 10 to about 200 microns;
 - (ii) from about 10 to about 80% of a solvent having a solubility parameter of less than or equal to about 9 (cal./cm³)^{1/2}; and
 - (iii) optionally, from about 0% to about 90% water.